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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,140	04/07/2004	Robert F. Mataya	TKMA.111006	8937

7590 09/27/2005

William B. Kircher  
SHOOK, HARDY & BACON L.L.P.  
2555 Grand Boulevard  
Kansas City, MO 64108-2613

EXAMINER
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OLSON, LARS A

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/821,140

Applicant(s)

MATAYA, ROBERT F.

Examiner

Lars A. Olson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 and 15-22 is/are allowed.
- 6) ☒ Claim(s) 10 and 11 is/are rejected.
- 7) ☒ Claim(s) 12-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. A response was received from the applicant on August 17, 2005.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoda (US 3,840,319).

Rhoda discloses a mold insert for use with boat hull molds, as shown in Figures 1-14, that is configured to form an inboard/outboard propulsion system passageway in a boat hull, said insert being comprised of a semi-rigid body, defined as Part #16, having an inboard surface, an outboard surface, and a tapered sidewall that spans between said inboard and outboard surface.

Rhoda, as set forth above, discloses all of the features claimed except for the use of a mold insert with a body having a shore D hardness value of less than 90, a shore A hardness value of greater than 65, and a material selected from polyurea, polyurethane, and a polyurea/polyurethane compound.

The use of a mold insert body that is made from a specific material would be considered by one of ordinary skill in the art to be an obvious design choice based upon

the required strength and physical characteristics of the material for said mold insert body.

The use of a mold insert body that is made from a material having a specific shore A or shore D hardness value would also be considered by one of ordinary skill in the art to be an obvious design choice based upon the required strength and desired flexibility of the material for said mold insert body.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to utilize a mold insert body made from a specific material having a specific shore A and shore D hardness value in combination with the mold insert as disclosed by Rhoda for the purpose of providing a mold insert for use in the fabrication of a boat hull that is both strong and flexible in order to facilitate the formation of an inboard/outboard propulsion system passageway in said boat hull.

#### ***Allowable Subject Matter***

4. Claims 1-9 and 15-22 are allowed.
5. Claims 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

6. Applicant's arguments filed on August 17, 2005 regarding claims 10 and 11 have been fully considered but they are not persuasive.

7. The applicant argues that the use of a semi-rigid mold insert with a shore D hardness value of less than about 90 and a shore A hardness value of greater than about 65 is not an obvious design choice to one of ordinary skill in the art.

8. In response to the applicant's argument, the applicant has stated that the materials choice for the claimed mold insert depends on the range of flexibility of the insert material, and the rigidity required for maintaining the shape of said insert during a molding process. The applicant then chose the shore hardness values for said mold insert as claimed so that said mold insert was capable of functioning as intended during the molding process. This is clearly a design choice based upon the required strength and desired physical characteristics of the material to be utilized for forming a mold insert, which is not an inventive step. Therefore, for the reasons given above, the rejection of claims 10 and 11 is deemed proper and is not withdrawn.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication from the examiner should be directed to Exr. Lars Olson whose telephone number is (571) 272-6685.

lo

September 23, 2005

**LARS A. OLSON**  
**PRIMARY EXAMINER**

*Lars Olson*  
9/23/05